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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,655	02/19/2004	Yasuo Mori		3593

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

SINGH, SATWANT K

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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12/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/780,655

Applicant(s)

MORI ET AL.

Examiner

Satwant K. Singh

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/14/04, 12/12/07.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 13-18, while defining a computer program product do not define a "computer-readable medium" and are thus non-statutory for that reason. A computer program product can range from paper on which the program is written to a program simply contemplated and memorized by a person. The examiner suggests amending the claims to embody the program product on a "computer-readable medium" in order to make the claim statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishikawa et al. (US 7,145,687).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

5. Regarding Claims 1, 7, and 13, Nishikawa et al discloses a document processing comprising: registering print settings for a document being edited as template information (printing data from an application is saved in the intermediate save file) (col. 16, lines 64-67, col. 17, lines 1-4); and reading the template information registered as print settings for the document being edited or a new document (printing control application reads data stored in the save file) (Col. 17, lines 9-21).

6. Regarding Claims 2, 8, and 14, Nishikawa et al discloses editing the contents of a template registered in said registration step (change in a print setting in data saved in the save file is made) (col. 20, lines 46-54).

7. Regarding Claims 3, 9, and 15, Nishikawa et al discloses wherein said document has a tree structure with pages as leaves (Fig. 22); print settings are settable for each subtree (Figs. 8 and 9); and registers print settings set for the whole of said tree structure as a template (Fig. 22) (col. 14, lines 27-43).

8. Regarding Claims 4, 10, and 16, Nishikawa et al discloses wherein said document has a tree structure with pages as leaves (Fig. 22); print settings are settable for each subtree (Figs. 8 and 9); settings made at a lower hierarchy are preferentially

applied to overlapped setting items; and registers print settings to be applied to a selected subtree as a template (interface windows are used as input windows for inputting instructions to make changes in data in save file).

9. Regarding Claims 5, 11, and 17, Nishikawa et al discloses further comprising editing said document, wherein print settings are changeable (change in a print setting in data saved in the save file is made) (col. 20, lines 46-54).

10. Regarding Claims 6, 12, and 18, Nishikawa et al discloses wherein said print settings include at least any of printing method, paper direction, gutter and binding direction, page layout, enlargement/reduction, watermark, header and footer, paper discharge method, setting of bookbinding, cover and back cover, index paper, slip paper and chapter separation (col. 9, lines 64-67, col. 10, lines 1-49).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nishikawa et al. (US 2003/0159114) discloses to automatically determine by a printing system on the basis of print settings and the like whether to output all records by a single print job or respective records by independent print jobs in variable printing.

Contact Information

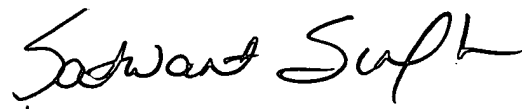
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


sks

Satwant K. Singh
Examiner
Art Unit 2625



Thomas D. Lee